

# ARNOLD & PORTER

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November 12, 2002

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Commissioner for Patents  
Washington, DC 20231

Re: U.S. Application No. 09/915,182  
Filed: July 25, 2001  
Title: **Nucleic acid sequences encoding beta-ketoacyl-ACP synthase and uses thereof**  
Applicants: Katayoon DEHESH  
Atty. Docket: 16518.087

Sir:

The following documents are forwarded herewith for appropriate action by the U.S. Patent and Trademark Office (PTO):

1. a Response to Restriction Requirement mailed October 9, 2002; and
2. a return postcard.

Please stamp the attached postcard with the filing date of these documents and return it to our courier.

In the event that extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned. Applicants do not believe any fees are due in conjunction with this filing. However, if any fees under 37 C.F.R. §§ 1.16 or 1.17 are required in the present application, including any fees for extensions of time, then the Commissioner is hereby authorized to charge such fees to Arnold & Porter Deposit Account No. 50-2387, referencing matter number 16518.087. A duplicate copy of this letter is enclosed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "David R. Marsh".

David R. Marsh (Reg. No. 41,408)  
Dawn M. Gardner (Reg. No. 44,118)

Attachments



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Katayoon DEHESH

Appln. No.: 09/915,182

Filed: July 25, 2001

For: **Nucleic acid sequences encoding  
beta-ketoacyl-ACP synthase and  
uses thereof**

Art Unit: 1638

Examiner: E. MCELWAIN

Atty. Docket: 16518.087

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**Response to Restriction Requirement**

Commissioner for Patents  
Washington, DC 20231

Sir:

In response to the Office Action mailed October 9, 2002, Applicants submit the following response.

**Remarks**

The application presently contains claims 1-36. In the Office Action dated October 9, 2002, the Examiner required restriction to one of the following inventions under 35 U.S.C. § 121:

Group I: Claims 1-21 and 31-36 drawn to DNA, cells and plants transformed with said DNA, classified in class 800, subclass 298, for example.

Group II: Claims 22-29, drawn to methods comprising transforming cells with DNA encoding a beta-ketoacyl-ACP synthase, classified in class 800, subclass 281, for example.

Group III: Claims 30 and 31, drawn to oil, classified in class 530, subclass 370, for example.



Applicants respectfully traverse the restriction requirement, and provisionally elect the claims of Group I, Claims 1-21 and 31-36 to the extent that the claims are drawn to DNA, cells, and plants transformed with said DNA, classified in class 800, subclass 298, for further prosecution.

Initially, Applicants would like to bring to the Examiner's attention that claim 31 has been assigned to both Group I and Group III. Claim 31 is directed to "[a] plant according to claim 17; wherein said plant consists of a soybean seed." It is believed that claim 31 has improperly been placed in Group III. Applicants will treat claim 31 as part of Group I rather than Group III, and request that the Examiner modify the Groups to remove claim 31 from Group III.

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Applicants submit that the complete examination of the application would be handled most expeditiously by treating all of the pending claims as a single entity. As section 803 of the MPEP directs, "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." Applicants respectfully submit that the Examiner has not shown that a search and examination of the entire application would cause a serious burden. Rather, a serious burden would arise if the application were restricted into the three groups of claims. Therefore, Applicants request that all of the claims be examined together at this time.

If the Examiner finds that there is an undue burden to examine all of the claimed together at this time, Applicants respectfully request that the Examiner modify the restriction requirement and consider the claims of Groups I and II together. Initially, it is noted that the  $\beta$ -ketoacyl-ACP synthase enzymes claimed in the claims of Group I can be used in the methods of Group II. It is believed that when searching for methods, such as those encompassed by claims 22-29, which include transforming or transfecting a cell with a polynucleotide sequence which encodes a  $\beta$ -

ketoacyl-ACP synthase enzyme, one would also find disclosures of the polynucleotide sequences themselves. Since only one search would be required to examine the claims of both Groups I and II, there would be no undue burden to examine the claims of these Groups together. Therefore, modification of the Restriction Requirement, so that claims 1-29 and 31-36 are examined together, is respectfully requested, and believed to be in order.

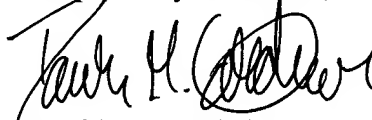
Furthermore, in accordance with Section 806.05(f) of the MPEP, a process of making a product and the product made may be examined together so long as (a) the process is an obvious process of making the product and the process can not be used to make other and different products; or (b) the product cannot be made by another and materially different process. The Examiner has not met her burden of showing why she believes the process of making the transformed cells having various properties (as claimed in claims 22-29) is a distinct invention from the transformed cells (as encompassed by claims 14 and 15 in Group I). For example, the Examiner has failed to show (1) why the transformation methods as claimed are not obvious methods of making the claimed modified cells; (2) that the claimed transformation methods can be used to make other and different products; or (3) that the modified cells can be made by another and materially different process. Since the Examiner has not met her burden of showing that the inventions of Groups I and II are distinct, the Examiner is respectfully requested to modify the Restriction Requirement so that claims 1-29 and 31-36 are examined together.

Based upon the foregoing, Applicants respectfully submit that the restriction requirement is improper and should be withdrawn. Alternatively, Applicants request that the Examiner modify the Restriction Requirement to examine the claims of Groups I and II together. However, to facilitate prosecution, Applicants have provisionally elected, with traverse, Group I, claims 1-21 and 31-36.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account Number 50-2387, referencing Docket number 16518.087. Applicants likewise authorize a charge to Deposit Account Number 50-2387 for any other fees related to the present application that are not otherwise provided for in the accompanying documents.

Should the Examiner have any questions regarding this application, the Examiner is encouraged to contact Applicants' undersigned representative at (202) 942-5000.

Respectfully submitted,



David R. Marsh (Reg. No. 41,408)

June E. Cohan (Reg. No. 43,741)

Dawn M. Gardner (Reg. No. 44,118)

Date: November 12, 2002

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